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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/692,988	10/20/2000	Frank Robertson Dawson JR.	RSW920000076US1	8088

7590   01/29/2004

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EXAMINER
MASHAAL, ALI M

ART UNIT	PAPER NUMBER
2136	

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/692,988	Applicant(s) DAWSON ET AL.
	Examiner Ali M. Mashaal	Art Unit 2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>02 June 2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-31</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-31</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>20 October 2000</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.
37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific
reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2 & 3</u>

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

DETAILED ACTION

1)   This action is in response to the application filed 10/20/2000.

2)   Claims 1-31 are under examination.

Claim Objections

3.1)   Claims 1-9, 3, 13, and 27-29 are objected to because of the following informalities:

As per claim 1, line 5 recites "placing new data..." and line 6 apparently referring to the same data recites "wherein the new information..." The language must be consistent throughout the claim, so that it recites either "new data" or "new information" but not both, wherein the language is also consistent with the steps of maintaining, combining, and performing.

Claims 2-9 are objected to by virtue of their dependencies upon an objected base claim.

As per claim 3, an apparent typo on line 1 of the claim: "The method of claim <u>A1</u>" must read "The method of claim <u>1</u>."

As per claim 13, lines 3-4 cite "a memory connected to the bus system, wherein the memory <u>includes as set</u> of instructions;" The structure is apparently grammatically incorrect. However for the sake of this office action examiner interprets it as "includes a set..."

As per claim 27, line 2 of the claim should be preceded with a semicolon (;) for the sake of clarity.

Claims 28 and 29 are objected to by virtue of their dependencies upon an

objected base claim.

All appropriate corrections are required.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4.1   Claims 1, 4, 5, 9, 10, 13,18, 21, 22, 26, 27, 30, and 31 are rejected under 35

U.S.C. 102(a) as being clearly anticipated by Hot!NEWstuff: *McAfee: Antivirus software*

for handhelds to Meikle.

As per claims 1, 18, 30, and 31, Meikle teaches a method/data processing

system/computer program product for preventing exchange of viruses, comprising:

maintaining preexisting content for a device in a first location (the handhelds in Meikle

maintain preexisting content which is to be synchronized with the content on a pc);

placing new content associated with the device in a second location (the new content is

on the pc in Meikle), wherein the new content is an update to the preexisting content

(Meikle says that the operation is a synchronization. This constitutes an update to

preexisting content); combining the preexisting content and the new content in a third

location to form merged content and performing a check for viruses on the merged

content prior to performing a transfer of the new content (prior to the completion of the

synchronization the pc scans content located on the handheld by uploading it, and then

the synchronized/merged content is uploaded to the handheld).

As per claims 4, 5, 21, and 22 Meikle further discloses that the product described

is intended for devices to include wireless devices such as cell phones (see bottom of

page 12, and top of page 13, in which the need for the product is established in part by

the fact that some cell phones have all ready been attacked by a virus).

As per claims 9 and 26, Meikel further teaches that the computer "scans the

handheld device when files on the pc and handheld are synchronized." See page 13,

first full paragraph.

As per claims 10 and 27, Meikle teaches a method/system in a data processing

system for preventing transmission of viruses, comprising the steps of: receiving a

request to synchronize a device, (see Meikel page 13, first full paragraph: "scans the

handheld device when files on the pc and handheld are synchronized.") As per

identifying new content associated with the device, again because Meikel teaches a

synchronize process, this constitutes identifying new content associated with the device.

As per combining the new content with existing content to form merged content and

checking the merged content for viruses prior to synchronizing the device, in Meikel

(prior to the completion of the synchronization the pc scans content located on the

handheld by uploading it, and then the synchronized/merged content is uploaded to the

handheld).

As per claim 13, Meikle teaches a data processing system comrprising: a bus

system (see Meikel page 13, first full paragraph: "...the antivirus software doesn't yet

run on the handheld itself. Instead, it runs only on a desktop computer...") A bus

system is an inherent property in a desktop computer. Furthermore, "A memory

connected to the bus system," and "a processing unit connected to the bus system", are

also inherent properties of a desktop pc. As per maintaining preexisting content for a

device in a first location (the handhelds in Meikle maintain preexisting content which is

to be synchronized with the content on a pc); placing new content associated with the

device in a second location (the new content is on the pc in Meikle), wherein the new

content is an update to the preexisting content (Meikle says that the operation is a

synchronization. This constitutes an update to preexisting content); combining the

preexisting content and the new content in a third location to form merged content and

performing a check for viruses on the merged content prior to performing a transfer of

the new content (prior to the completion of the synchronization the pc scans content

located on the handheld by uploading it, and then the synchronized/merged content is

uploaded to the handheld).

Claim Rejections - 35 USC § 103

5)   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.1)   Claims 2, 3, 8, 11, 12, 14-17, 19, 20, 25, 28, and 29 are rejected under 35 U.S.C.

103(a) as being unpatentable over Hot!NEWstuff: *McAfee: Antivirus software for*

handhelds to Meikle.

As per claims 2, 3, 19, and 20, Meikle discloses all limitations of the base claims

as discussed above. Furthermore, although not explicitly disclosed in the Meikle

teaching, it would have been obvious to one having ordinary skill in the art at the time

the invention was made that this is in fact the normal operating procedure of the Mcafee

product disclosed, because upon scanning for viruses as disclosed by Meikle the only

sensible thing to do in order to prevent virus transmission, (which is clearly the goal in

the Meikle disclosure), would be to send the update back to the handheld only if a virus

is not present in the merged/synchronized content, where the content would then be

stored as the preexisting content.

As per claims 8 and 25, Meikle teaches all limitations of the base claims. Meikle

does not explicitly teach wherein the third location is a random access memory in the

data processing system. However, it would have been obvious to one having ordinary

skill in the art at the time the invention was made to modify the teaching of Meikle such

that the content would be merged in the Ram of the data processing system, because

RAM is known for its speed and is known to be particularly useful for temporary storage

tasks.

As per claims 11, 12, 28, and 29, Meikle teaches that the antivirus

method/system performs the scan of content during synchronization (see Meikel page

13, first full paragraph). It is well known in the art that a synchronization between a pc

and handheld can be done treating either the pc data as the "new content" thus

updating the handheld, or the handheld data as the "new content" thus updating the pc.

As per claims 14 and 15, Meikle teaches the limitations of the base claims.

Meikle does not explicitly disclose wherein the bus system includes a primary bus and a

secondary bus or wherein the bus comprises a single bus, but only teaches a pc

inherently having at least a bus. It is well known in the art that desktop computers may

have a primary and secondary bus, and that the use of one as opposed to the other is

an obvious design choice.

As per claims 16 and 17, Meikle teaches all limitations of the base claims, but

does not explicitly disclose wherein the processing unit includes a plurality of

processors or a single processor, but only discloses a pc inherently having at least a

processor. It is well known in the art that desktop computers may have a single

processor or multiple processors, and that the implementation of one as opposed to the

other is an obvious design choice.

5.2)   Claims 6, 7, 23, and 24 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Hot!NEWstuff: *McAfee: Antivirus software for handhelds* to Meikle, in

view of PC WORLD:*Do Handhelds Need Virus Protection?* to Silver.

As per claims 6, 7, 23, and 24, Meikle teaches all limitations of the base claims.

Furthermore, because (as disclosed by Meikle) the anti-virus software is designed to

work on such devices as those running the Palm OS, and Windows CE, its clear that

the first location is a hard disk, because the devices that run Palm OS and Windows CE

store there data on a hard disk. Meikle fails to teach the hard disk drive being in the

data processing system. However, Silver in an analogous art discloses the hard disk

drive being in the data processing system as an alternative approach. See page 1,

under "Alternative Approaches". It would have been obvious to one having ordinary skill

in the art at the time the invention was made to choose any of the approaches (having

the hard disk in the data processing system as taught by the Mcafee approach

according to Silver, or having the hard disk on a remote pc as taught by the Symantec

approach according to Silver) as alternative solutions to scanning handhelds for viruses.

This constitutes wherein the first location is a hard disk drive in the data processing

system as in claims 6 and 23, as well as wherein the first location is a hard disk in a

storage system remote to the data processing system as in claims 7 and 24.

Conclusion

6.1)   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

The following is a list of pertinent prior art:

<u>US PATENTS</u>

6,275,938

5,974,549

6,067,618

5,892,904

US PUBLICATIONS

2002/0013910A1

NONPATENT LITERATURE

Meikle, Patrick. Hot!NEWstuff: McAfee: Antivirus software for handhelds

to Meikle. August 21, 2000.

Silver, Karen. PC WORLD:Do Handhelds Need Virus Protection. June

29, 2000.

6.2)   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Ali M. Mashaal whose telephone number is 703-305-

7854. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for

the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is 703-305-

3900.

EMMANUEL L. MOISE
AM   PRIMARY EXAMINER